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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,661	11/10/2003	Dale F. McIntyre	87231F-P	6147

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EXAMINER	
TRAN, MYLINH T	

ART UNIT	PAPER NUMBER
2179	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/705,661	MCINTYRE, DALE F.	
	Examiner	Art Unit	
	Mylinh Tran	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment filed 02/05/07 has been entered and carefully considered. Claims 2, 12-20 have been amended. However, limitations of the amended claims have not been found to be patentable over prior art of record, therefore, claims remain rejected under the same ground of rejection as set forth in the Office Action mailed (11/15/05).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-31 and 38-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Termotto [US. 2005/0046643].

As to claims 1, 11, 21, 31 and 38, Termotto teaches a computer implemented method and corresponding apparatus for providing a customized image product to a user comprising the steps/means for obtaining a computer readable media having a software program such that when said computer readable media is placed in a user computer said software will cause said user computer to perform a predefined series of steps used to create said customized image product from a template (page 1, 0007 and page 2, 0027-0028), said computer readable media provides for accessing digital image content (page 2, 0027-0028); loading said computer readable media in said user computer and

thereby causing activation of said software, said software automatically allowing use of said digital image content (page 2, 0028), said user composing said customized image product (page 1, 0007).

Termotto fails to teach a credit toward the cost of said customized image product and a unique identifier said user ordering said customized image product wherein said unique identifier is used to identify said credit and said template. However, it was well known in the art that Termotto teaches these features because Termotto teaches selecting an image and customizing with text and/or graphics by the customer online using online tools provided on a website. Termotto also teaches the customer proofing the image online, placing an order and the created file being sent to a printing center.

It would have been obvious to one of skill in the art, at the time the invention was made, to combine the well known implementations with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claims 2, 12, 22 and 41, Termotto teaches computer readable media comprising a CD, a computer floppy disc (page 1, 0005-0006).

As to claims 3, 13, 23 and 42, Termotto fail to clearly teach customized image product comprising one of a book, a post card, a greeting card. However, it was well known in the art that Termotto teaches these features because Termotto teaches a image product. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the well known implementations

with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claims 4, 14, 24 and 43, Termotto teaches credit comprising the full cost of said customized image product (page 1, 0005-0006).

As to claims 5, 15, 25 and 44, Termotto also teaches the template being provided on said computer readable media (page 1, 0007-0008).

As to claims 6, 16, 26 and 45, Termotto teaches software program providing for communication with a fulfillment provider over a communication network for placement of said order (see abstract).

As to claims 7, 10, 17, 20, 27, 30, 46 and 49, it is inherent that Termotto teaches unique identifier being used to obtain said digital image content from said fulfillment provider because each of the image product has it own identifier.

As to claims 8, 18, 28 and 47, Termotto also teaches content being provided on computer readable media (page 1, 0007-0008).

As to claims 9, 19, 29 and 48, Termotto teaches the digital image content being obtained with respect to image(s) that were captured on film and scanned so as to create said digital image content (page 2, 0027-0028).

As to claim 39, Termotto teaches the plurality of images providing by said user on a portable digital memory device (page 1, 0014).

As to claim 40, Termotto also teaches the plurality of images providing by said user on a digital image capture device (page 1, 0014).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Termotto [US. 2005/0046643] in view of Haeberli [US. 6,941.276]

As to claim 32, Termotto fails to clearly teach fulfillment provider comprising a film product. However, Haeberli teaches the feature at (column 1, lines 15-57). It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's s film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claim 33, Termotto fails to clearly teach film product comprising undeveloped film that needs to be developed and scanned in order to obtain said digital images. However, Haeberli teaches the feature at (column 2, lines 20-45).

It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claim 34, Termotto fails to clearly teach an order form being used to identify a particular type image product from which said customized image product is to be made.

However, Haeberli teaches the limitation at column 4, lines 15-60. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claim 35, Termotto fails to clearly teach order form being used to identify digital image content to be included in said computer readable media. However, Haeberli shows the limitation at column 2, lines 15-40. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claim 36, Termotto fails to clearly teach at least one of the identified digital image content being royalty bearing. However, Haeberli shows the limitation at column 14, lines 15-40. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

As to claim 37, Termotto fails to clearly teach said plurality of images being provided to said fulfillment provider over a communication network. However,

Haeberli shows the feature at column 2, lines 15-55. It would have been obvious to one of skill in the art, at the time the invention was made, to combine the Haeberli's film product with the teachings of Termotto, Motivation of the combination would have been a fair practice to promote business.

Response to Arguments

Applicant has argued that Termotto does not teach or suggest providing a computer media having a program that is executable on the user computer. The examiner respectfully disagrees because Termotto, as disclosed at pages 1-2, cites "Those skilled in the art will appreciate that the concept upon which this disclosure is based may readily be utilized as a basis for designating other structures, methods and **systems for carrying out the several purposes of this development**. It is important that the claims be regarded as including such equivalent methods and **products** resulting therefrom that do not depart from the spirit and scope of the present invention". It is clearly that the Termotto's system provides for creation on the user computer.

Applicant also argued that Termotto fails to clearly teach a credit which is applied to the cost of the customized image product. However, Termotto shows the feature at page 1, 0005 cited "This procedure often results in a rather expensive final project particularly when the needed volume of posters or banners is low. The cost of custom printing a small quantity or batch results in the price for such items being substantially greater the prices of convention non-customized posters or banners.

Applicant also argued that Termotto fails to clearly teach a unique identifier being associated with the computer readable media. However, Termotto teaches selecting an image and customizing with text and/or graphics by the customer online using online tools provided on a website. Termotto also teaches the customer proofing the image online, placing and order and the created file being sent to a printing center. When a user accesses to a template to get a desired image, user's unique identifier has to be provided in order to access into the template.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mylinh Tran

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